

#18

Attorney Docket No.: 97-106 CIP
Serial No.: 09/145,690

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Charles J. Long, Jr.)
Serial No.: 09/145,690)
Filed: September 2, 1998)
Group Art Unit: 3727)
Examiner: Hylton, Robin/Cronin, Stephen)
Our Ref: 97-106 CIP)

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CLOSURE

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FEB 07 2001

OFFICE OF PETITIONS

Commissioner of Patents and Trademarks
Washington DC 20231

February 2, 2001

Sir/Madam:

**RENEWED PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181
FOR ENTRY OF AMENDMENT AFTER FINAL REJECTION; AND REQUEST FOR
RECONSIDERATION PURSUANT TO 37 C.F.R. 1.116**

In response to the Examiner's Advisory Action on the above identified application, mailed July 21, 2000 (appended hereto as Exhibit "A"), and the Examiner's Response Supplemental to Decision filed on October 11, 2000 (appended hereto as Exhibit "C"), and in light of the Decision on Petition entered on September 18, 2000 (appended hereto as Exhibit "B") and disposing of the PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181 FOR ENTRY OF AMENDMENT AFTER FINAL REJECTION; AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. 1.116 (the "Original Petition") filed August 18, 2001; Applicant respectfully petitions the Commissioner, pursuant to 37 C.F.R. 1.181, for entry of the

amendments to the above-identified application presented in the AMENDMENT filed by Applicant on July 6, 2000 (appended hereto as Exhibit "D"); and also requests reconsideration and allowance of the present application pursuant to 37 C.F.R. 1.116, based on the aforesaid amendments and the reasons set forth below.

This Renewed Petition is based on the refusal of the Examiner to enter the AMENDMENT, which was the subject of the Original Petition. In the Response Supplemental to Decision, the Examiner refused to comply with the Decision on Petition, which disposed of the Original Petition by stating as follows:

It appears to the undersigned that in this application, it would be appropriate to have the examiner reconsider the refusal to enter the amendment, and if such refusal is still deemed proper, *to have the record reflect the examiner's rationale in light of the arguments presented in the petition.*¹

In the Response Supplemental to Decision, the Examiner did not provide any rationale, or other information whatsoever, to support his refusal to enter the AMENDMENT, other than merely repeating essentially verbatim the same comments made in the Advisory Action, without providing any evidence and/or argument whatsoever to address the points made in the Original Petition, which served as the basis for the conclusion in the Decision on Petition that the Examiner should reconsider his refusal to enter the AMENDMENT. As a result, this Renewed Petition has been filed seeking entry of the AMENDMENT.

The Examiner has refused entry of the aforesaid amendments, which were necessitated by final rejection of the claims and were not earlier presented for that reason, based on the claim that

¹ See Decision on Petition; appended as Exhibit "B" to Renewed Petition.

they (i) raise new issues that would require further consideration and/or search; and (ii) are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the Examiner contends that the amended claims as proposed do not overcome the combination/subcombination rejection set forth in the final Office Action dated March 28, 2000, and that the amendments raise new issues with respect to the combination of the closure and container. Applicant respectfully traverses and requests the Commissioner to overrule the Examiner's refusal to enter the amendments presented in Exhibit "D", on the basis that the aforesaid amendments add no new subject matter to that already present in the claims before the final rejection was made, and thus raise no new issues requiring further consideration and/or search.

The amendments presented to Claims 7 and 8 in the AMENDMENT of Exhibit "1" address the 35 U.S.C. § 112 rejections raised by the Examiner in the final Office Action and present no new subject matter. Instead, these amendments make changes of only an editorial nature that are intended to place the claims in a condition for allowance by overcoming those rejections. Furthermore, the refusal to enter these amendments is improper as both Claims 7 and 8 multiply depend from Claim 25 -- itself a combination claim to which the combination/subcombination rejection in the final Office Action is inapplicable.

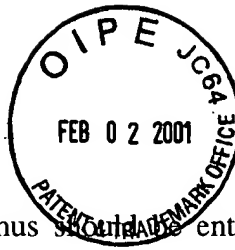
Because they present no new matter, these amendments raise no issue of lack of proper disclosure or undue breadth. As a consequence, the 35 U.S.C. § 112 rejections raised in the final Office Action are considered to be "technical" in nature under the standards of the Manual of Patent Examining Procedure (MPEP), and Applicant's attempt to amend the claims to overcome these rejections should not be refused consideration on appeal if those amendments would

otherwise place the application in a condition for allowance over the prior art. See MPEP § 706.03:

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Moreover, separate and apart from the amendments to Claims 7 and 8, the proposed amendments to Claims 1, 22 and 25 only incorporate the previously-examined limitations of cancelled Claims 21, 23 and 24 and thus raise no new issues. Moreover, these amendments in fact place the case in better form for appeal, by reducing the questions presented on prior art to the single consideration of whether the remaining claims are allowable under 35 U.S.C. § 103 in light of the combination of U.S. Patent No. 4,448,319 to Kern with U.S. Patent No. 5,056,675 to Julian, which was the only asserted basis for rejection of the cancelled claims over prior art.

Presumably, in reviewing the AMENDMENT of Exhibit "D", the Examiner has followed the requirements of MPEP § 714.13 (i.e., *"the proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.... Applicants should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal...."*) By eliminating all prior art issues except for one, the amendments must at the very least be considered to place the claims in a better form for appeal by materially reducing and/or



simplifying the issues for appeal, and thus should be entered. See MPEP § 714.12 ("[a]ny amendment that will place the case either in a condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 C.F.R. § 1.116(a).")

In response to the Office Action mailed March 28, 2000 finally rejecting the claims of the above-identified application, Applicant thus respectfully requests entry of the amendments presented in the AMENDMENT filed on July 6, 2000 (appended hereto as Exhibit "D"). Additionally, reconsideration and allowance of the appealed claims, as so amended, is respectfully requested based on the reasons set forth in the aforesaid AMENDMENT.

Respectfully submitted,
CHARLES J. LONG, JR.

By: 

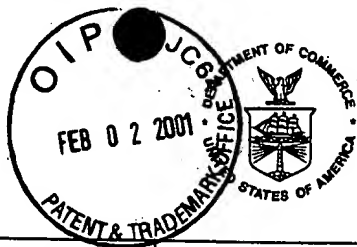
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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/145,690	09/02/98	LONG JR.	C 97-106CIP

THOMAS C WETTACH
TITUS & MCDONALD
TWENTIETH FLOOR
FOUR GATEWAY CENTER
PITTSBURGH PA 15222

QM12/0721

EXAMINER

HYLTON, R

ART UNIT	PAPER NUMBER
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3727

DATE MAILED:

07/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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FEB 07 2001

OFFICE OF PETITIONS

Advisory Action

Application No.

09/145,690

Applicant(s)

Long, Jr.

Examiner

Robin A. Hylton

Group Art Unit

3727



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 4 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jul 6, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The claims, as proposed, do not overcome the combination/subcombination rejection set forth in the previous Office action and additionally create a new issue with respect to the combination of the closure and a container. Further, the rejection set forth under 35 USC 103 in the previous Office action is final since any removal of a cap from a container will inherently lift the tamper indicating ring to a certain degree. See fig 4 of Julian.

- ☐ Applicant's response has overcome the following rejection(s): _____
- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: _____
- Claims objected to: _____
- Claims rejected: 1-24
- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other _____

Allan N. Shoap
Supervisory Patent Examiner
Group 3700

B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

SEP 18 2000

Paper No. 14

In re Application of
Charles J. Long, Jr.
Application No. 09/145,690
Filed: September 2, 1998
Attorney Docket No. 97-106CIP

:
: DECISION ON PETITION
:
:

This is a decision on the petition filed on August 18, 2000 seeking supervisory review of the examiner's refusal to enter the amendment after final rejection filed on July 6, 2000.

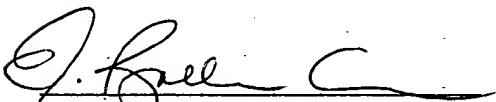
The petition is dismissed.

No fee is required for this petition under 37 CFR 1.181. It is noted that on July 26, 2000, petitioner also filed an Information Disclosure Statement(IDS) accompanied by the petition required by 37 CFR 1.97(d). A fee in the amount of \$130.00 is required for that petition, and the fee applied to the present petition will instead be considered as having been applied to the petition which accompanied the IDS.

Under 37 CFR. 181(c), it may be required that a request for reconsideration and repeated action by the examiner be of record prior to the filing of a petition. It appears to the undersigned that in this application, it would be appropriate to have the examiner reconsider the refusal to enter the amendment, and, if such refusal is still deemed proper, to have the record reflect the examiner's rationale in light of the arguments presented in the petition.

Therefore, this application is being forwarded to the examiner for reconsideration of the propriety of refusing to enter the amendment after final action filed on July 6, 2000. In addition, the examiner should also consider whether the IDS filed on July 26, 2000 meets the requirements of 37 CFR 1.98, and to then take appropriate action with respect thereto.

PETITION DISMISSED.


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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C



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/145,690	09/02/98	LONG JR.	C 97-106CIP

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QM12/1011

EXAMINER	
HYLTON, R	
ART UNIT	PAPER NUMBER
3727	15

DATE MAILED:

10/11/00

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

*See attached letter &
IDS.*

Art Unit: 3727

Response Supplemental to Decision

1. It is the examiner's position that the after final amendment filed July 6, 2000, will not be entered. First, the proposed claim amendments create a new issue under 35 USC 112, second paragraph with respect to claim 1 (combination/subcombination issue). Secondly, the proposed amendments do not overcome the rejections set forth in the previous Office action and are not allowable. And third, the proposed claim amendments do not materially reduce the issues, but rather creates another (under 35 USC 112, second paragraph).

2. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (703) 308-1208. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. (Eastern time).

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ebony Smith at (703)305-3570.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148. The fax phone number for this Group is (703) 305-3579.

Robin A. Hylton/rah
October 4, 2000


Allan N. Shoap
Supervisory Patent Examiner
Group 3700

INFORMATION DISCLOSURE CITATION

(Use separate sheets if necessary)



Docket Number

97-106 C

Application Number

09/145,690

Applicant(s)

Charles J. Long, Jr.

Filing Date

September 2, 1998 -

Group Art Unit

3754

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL	REF	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
DA		5,657,906	08/1997	Rapchak et al.			
RA		5,662,247	09/1997	Rapchak et al.			

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FOREIGN PATENT DOCUMENTS

	REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

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TC 3700 MAIL ROOM

EXAMINER

R. H. H. H.

DATE CONSIDERED

10/2/00

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP Section 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

D

1. (twice amended) A tamper indicating closure configured for snap-on or

screw-on application to a container, said closure comprising:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;
- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element;

wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and

wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper

indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.

7. (twice amended) The tamper indicating closure of Claim 1 or 25, wherein said [container neck additionally comprises] frangible element is broken by a projection located on said container neck and configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

8. (twice amended) The tamper indicating closure of Claim 6, wherein said [container neck contains at least one] frangible element is broken by a projection located on said container neck and configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

22. (amended) The tamper indicating closure of Claim [21] 1 or 25, wherein at least one said arcuate projection comprises a locking member extending radially inward from said tamper indicating ring at an angle to a plane normal with said tamper indicating ring.

25. (amended) A tamper indicating closure configured for snap-on or screw-on application to a container, said closure and container comprising in combination:

a. a closure top portion;

b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;

c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and

d. a tamper indicating ring connected to said depending skirt by a frangible element;

wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and

wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.

REMARKS

Applicant respectfully submits that the foregoing amendments are sufficient to place the application in a condition for allowance.

Claim Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 7 and 8, and all other claims dependent on either of them along with Claim 1, for indefiniteness on the basis that the preamble of those claims is directed to a closure while the body of those claims positively introduces the projection structure of the container. Applicant respectfully traverses this rejection based on the amendment to Claims 7 and 8 set forth herein, which overcomes the rejection in no longer setting forth the container structure as a positively recited element.

Claim Rejections under 35 U.S.C. §§ 102 and 103:

In the final Office Action, the Examiner has withdrawn all of the previous bases for rejection of the claims and now asserts that (i) Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045; (ii) Claims 1-6, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 with Sander, U.S. Patent No. 5,487,481; (iii) Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25 in combination with Csaszar, U.S. Patent No. 4,343,408; (iv) Claims 11, 13 and 14 are obvious in light of the prior art as applied to Claim 1 or 25 in combination with Montgomery, U.S. Patent No. 5,379,910; (v) Claims 17 and 19 are

obvious in light of the prior art as applied to Claim 1 or 25 in combination with Repp et al., U.S. Patent No. 5,593,055; and (vi) Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675. The Examiner has indicated that Claims 7, 8, 10, 12, 15, 16, 18 and 20 (as dependent from Claims 1 and 25) are allowable over the prior art and would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of base Claims 7 or 8 and any intervening claims.

As dependent from Claims 1 and 25 as amended herein, it is respectfully submitted that all claims are now in a condition for allowance, as Claims 1 and 25 now incorporate the limitations of Claims 21, 23 and 24 to require:

"... a tamper indicating ring connected to said depending skirt by a frangible element; wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection."

It is believed that this amendment now places Claims 1 and 25 and all remaining claims (as dependent therefrom) in a condition for allowance, as the only basis for rejection of Claims

23 and 24 was the combination of Kern and Julian, where Julian was cited as disclosing the foregoing limitation added to Claims 1 and 25. However, Julian does not disclose a tamper indicating band having the claimed "*arcuate projection*", but instead teaches only ratchet teeth 52 that do not allow rupture of the tamper indicating band in a manner equivalent to the claimed requirement that "*said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection*".

Instead of allowing movement of the tamper indicating ring "*upward to cause breakage of said frangible elements and fracture of said weakened area*" as required by the instant claims, the ratchet teeth 52 cause the tamper evident band to stay stationary as breakage of the band occurs by circumferential (and not upward) movement to sever frangible elements 34/34' and 50/50' as shown in Figs. 4-7 of Julian:

Likewise, in the unthreading direction, the stop surfaces 54 of the band ratchet teeth 52 will engage the stop surfaces 60 of the container neck ratchet teeth 58 to prevent further rotation of the tamper indicating band 30 relative to the container 24.... Referring to Fig. 4 as the cap 12 is further turned in the unthreading direction after the band ratchet teeth 52 have engaged the container neck ratchet teeth 58, the band 30 will remain stationary with respect to the container neck, but the cap will *turn* relative to the band ... until the axially extending frangible webs 34 will become fractured as shown at 34'.... Continuing rotation in the direction of the

arrow as shown in Fig. 5 will further flex the permanent flexible web 36 so that [t]he circumferentially extending frangible webs 50 will now be put under fracturing tension so that additional *rotation* of the cap in the direction of the arrow as shown in Fig. 6 will fracture these webs as shown at 50'. (See Julian; at column 5, lines 5-68; and at Figs.4-7.)

As with the prior withdrawn rejection of these claims as based on Beck, U.S. Patent No. 5,215,204, permanent flexible web 36 in Julian does not assist in breaking tamper indicating ring 30 by pulling the tamper indicating ring upward. This distinction over Beck as drawn in Applicant's response to the initial Office Action was accepted as a basis for withdrawing the rejection, and applies equally to the present rejection based on Julian.

For the foregoing reasons, in addition to the reasons set forth in Applicant's response to the initial Office Action for distinguishing over the prior art of record, the currently cited references cannot anticipate¹ or render obvious² Claims 1 or 25 or any other pending claim of the

¹ See MPEP § 2131 (citing *In re Bond*, 910 F.2d 831, 832 (Fed.Cir. 1990))(for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be *identically shown* in that reference, and the elements must be arranged as in the claim under review); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed.Cir. 1994)(to serve as the basis for a 35 U.S.C. § 102 rejection, the relied upon reference must contain *all* the limitations of the rejected claim); *PPG Industries v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ.2d 1618, 1624 (Fed.Cir. 1996)("[t]o anticipate a claim [under 35 U.S.C. § 102] a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter").

² See *Motorola v. Interdigital Technology Corp.*, 121 F.3d 1461, 1471, 43 USPQ.2d 1481, 1489 (Fed.Cir. 1997)("[i]n order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method")(citing *Beckman Instruments, Inc. v. Producter AB*, 892 F.2d 1547, 1551, 13 USPQ.2d 1301, 1304 (Fed.Cir. 1989)). See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1552-53 (Fed.Cir. 1983)("proceeding *contrary* to [i.e., "teaching away" from] the accepted wisdom in the art . . . is "strong evidence of nonobviousness"); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-80, 42 USPQ.2d 1378, 1383-84 (Fed.Cir. 1997)(same). See also *In re Gordon*, 733

present application (which all depend therefrom) as amended herein,³ because they are all based in whole or in part on the improper combination of these references.⁴ Thus, the Examiner's burden of establishing a *prima facie* case of unpatentability has not been made out based on the art of record, rendering the pending claims allowable as a matter of law.⁵

F.2d 900, 901-02, 221 USPQ 1125 (Fed.Cir. 1984)(reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "[the relied-upon reference] *teaches away from the board's proposed modification*")(alteration in original); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ.2d 1596 (Fed.Cir. 1988)(same). See MPEP § 2143.01 ("if the proposed modification or combination of the prior art would *change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious*"). See also *In re Gordon*, *supra*, 733 F.2d at 901-02 (reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "if [the prior art reference were modified in the manner suggested] *it would be rendered inoperable for its intended purpose*. . . . In effect, [the relied-upon reference] *teaches away from the board's proposed modification*")(alteration in original).

³ See *In re Fine*, *supra*, 837 F.2d at 1076 (dependent claims are allowable if independent claims from which they depend are allowable).

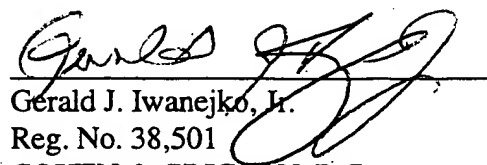
⁴ See MPEP § 2141.01(a)("in order to rely on a reference as a basis for rejection . . . the reference must . . . be in the field of applicant's endeavor or . . . reasonably pertinent to the *problem with which the inventor was concerned*"); see also MPEP § 904.01(c)(determination of analogous art "*depends on the necessary essential function or utility of the subject matter covered by the claims*"). See also *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products*, 21 F.3d 1068, 1071-72 30 USPQ.2d 1377, 1379-80 (Fed. Cir. 1994)(holding relied-upon references did not support rejection of obviousness because the trial court "*identified no reference that taught or suggested that [the elements of the claims] might be adapted to the [claimed combination] . . . when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination*")(alteration in original).

⁵ See MPEP § 2142 ("[w]ith regard to rejections under 35 U.S.C. § 103, the examiner must *provide evidence* which as a whole shows . . . [that] the reference teachings establish a *prima facie* case of obviousness"); MPEP § 2143.01 ("a statement that modifications of the prior art to meet the claimed invention would have been '*well within the ordinary skill of the art*' at the time the claimed invention was made . . . is *not* sufficient to establish a *prima facie* case of obviousness without some objective *reason* to combine teachings of the references")(citing *Ex parte Levengood*,

For the foregoing reasons, reconsideration and allowance of Claims 1-20, 22 and 25 as amended herein is respectfully requested.

Respectfully submitted,
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28 USPQ.2d 1300)(Bd.Pat.App.&Inter. 1993)("As adapted to ex parte procedure, Graham [v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)] has been interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for [its] rejection of an application under 35 U.S.C. § 102 or 103. . . . [A]n examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" (alteration in original))(also citing In re Fine, supra, 837 F.2d at 1074-76 ("[t]he relied-upon references] disclose at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability. The Examiner relies on hindsight to reach his obviousness determination. But this court has said '[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher'"(citing W.L. Gore & Associates v. Garlock, Inc., supra). See also In re Laskowski, 871 F.2d 115, 116, 10 USPQ.2d 1397, 1398 (Fed.Cir. 1989)(reversing Board of Appeals and Interferences affirmance of rejection based on obviousness since "the mere fact that the prior art could be so modified would not [make] the modification obvious unless the prior art suggested the desirability of the modification"); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ.2d 1780 (Fed.Cir. 1992)(same). See also In Re Bond, 910 F.2d 831, 834-35, 15 USPQ.2d 1566 (Fed.Cir. 1990) (rejecting a Board of Appeals and Interferences finding of obviousness where "critical differences exist between the claimed invention and the [relied-upon] prior art" (alteration in original)).